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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,318	10/05/2005	Koichi Otsuki	Q85515	9172
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SUGHRUE MION, PLLC 2100 Pennsylvania Avenue, N.W. Washington, DC 20037				
EXAMINER				
GOLDBERG, BRIAN J				
ART UNIT		PAPER NUMBER		
2861				
NOTIFICATION DATE		DELIVERY MODE		
07/01/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/521,318

Applicant(s)

OTSUKI, KOICHI

Examiner

Brian J. Goldberg

Art Unit

2861

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
4a) Of the above claim(s) 1-23 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 24-36 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 14 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-850)
Paper No(s)/Mail Date See Continuation Sheet
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Inventor's Patent Application
6) ☐ Other: _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :1/14/05, 12/28/06, 3/19/07, 2/27/08, 4/10/08.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group III, claims 24-36, in the reply filed on 4/24/08 is acknowledged.
2. Claims 1-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/24/08.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. *IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990). Such claims may also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 35 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, is nonstatutory functional descriptive material.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 24, 26, 29-32, and 34-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Ham (US 6039481).
6. Regarding claim 24, Ham discloses "carrying means for carrying a recording medium (21 of Fig 2A and 3A); detection means (32 of Fig 3A,B) that can move in a direction that intersects (see Fig 2 and 3 where detection means moves in direction intersecting carrying direction) the carrying direction of said recording medium (vertical direction of Fig 2, right to left of Fig 3) and that is for detecting a width of said recording medium in the direction that intersects the carrying direction of said recording medium (col 4 In 44-57, col 5 In 10-26, col 6 In 31-50); and a recording head for ejecting liquid to record recording information (31 of Fig 2A,B); wherein ON/OFF of an operation through

which said detection means detects the width of said recording medium is settable (col 4 ln 40-43, col 6 ln 61 – col 7 ln 3).”

7. Regarding claim 26, Ham discloses “wherein the ON/OFF of the operation through which said detection means detects the width of said recording medium is initially set to either one of ON and OFF in accordance with a type of said recording medium (see Figs 4A,B, where different size recording mediums are shown such that the operation described with regards to claim 24 above can occur or not (col 6 ln 61 – col 7 ln 3) based on the type of recording medium).” Further, since the limitation set forth in this claim is directed to a method of using the claimed apparatus, the apparatus disclosed by Ham must only be capable of performing such a method step.

8. Regarding claim 29, Ham discloses “said detection means detects the width of said recording medium before said recording head starts the recording of the recording information to the recording medium (step S14 occurs before S16 of Fig 5).” Further, since the limitation set forth in this claim is directed to a method of using the claimed apparatus (or the order of method steps of use), the apparatus disclosed by Ham must only be capable of performing such a method step.

9. Regarding claim 30, Ham discloses “said detection means moves in the direction that intersects the carrying direction of said recording medium and detects the width of said recording medium based on whether or not said recording medium is present (col 4 ln 44-57, col 5 ln 10-26, col 6 ln 31-50).” Further, since the second limitation set forth in this claim is directed to a method of using the claimed apparatus, the apparatus disclosed by Ham must only be capable of performing such a method step.

10. Regarding claim 31, Ham discloses "said detection means (32) and said recording head (31) are both provided in/on a moving member (30 of Fig 3A,B) for moving in the direction that intersects (see Fig 2 and 3 where detection means moves in direction intersecting carrying direction) the carrying direction of said recording medium (vertical direction of Fig 2, right to left of Fig 3)."

11. Regarding claim 32, Ham discloses "said detection means has a light-emitting member (12b of Fig 2 and 3) for emitting light and a light-receiving member (32 of Fig 2 and 3) for receiving the light that is emitted by said light-emitting member, and detects whether or not said recording medium is present based on an output value of said light-receiving member (col 3 ln 57-60, col 4 ln 51-57)."

12. Regarding claim 34, Ham discloses "enabling ON/OFF of an operation through which said sensor detects the width of said recording medium to be settable (col 4 ln 40-43, col 6 ln 61 – col 7 ln 3)."

13. Regarding claim 35, Ham discloses "enabling ON/OFF of an operation through which said detection means detects the width of said recording medium to be settable (col 4 ln 40-43, col 6 ln 61 – col 7 ln 3)."

14. Regarding claim 36, Ham discloses "a recording apparatus (see Fig 1) including: carrying means for carrying a recording medium (21 of Fig 2A and 3A); detection means (32 of Fig 3A,B) that can move in a direction that intersects (see Fig 2 and 3 where detection means moves in direction intersecting carrying direction) the carrying direction of said recording medium (vertical direction of Fig 2, right to left of Fig 3) and that is for detecting a width of said recording medium in the direction that intersects the carrying

direction of said recording medium (col 4 ln 44-57, col 5 ln 10-26, col 6 ln 31-50); and a recording head for ejecting liquid to record recording information (31 of Fig 2A,B); and a main computer unit connected to said recording apparatus (col 2 ln 4-6); wherein ON/OFF of an operation through which said detection means detects the width of said recording medium is settable (col 4 ln 40-43, col 6 ln 61 – col 7 ln 3)."

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ham in view of Brookner (US 6234694).

17. Regarding claims 25 and 27, Ham discloses the claimed invention as set forth above regarding claim 24. Thus Ham meets the claimed invention except "wherein the ON/OFF of the operation through which said detection means detects the width of said recording medium is settable through a display screen" and "wherein the ON/OFF of the operation through which said detection means detects the width of said recording medium is initially set to either one of ON and OFF in accordance with a resolution at which the recording information is to be recorded to said recording medium."

18. Regarding claim 25, Brookner teaches setting operations "through a display screen (col 4 ln 6-10)." Regarding claim 27, since the limitation set forth in this claim is directed to a method of using the claimed apparatus, the apparatus disclosed by Ham in

view of Brookner must only be capable of performing such a method step. Since Brookner teaches a user input display screen, with the combination of Ham in view of Brookner, a user would be capable of setting the operation "in accordance with a resolution at which the recording information is to be recorded to said recording medium." It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to make the operation of Ham settable through a display screen as taught by Brookner to achieve the predictable result of allowing the user to more easily interact with and operate or set the recording apparatus.

19. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ham in view of Elgee (US 6213659).

20. Regarding claim 28, Ham discloses the claimed invention as set forth above regarding claim 24. Thus Ham meets the claimed invention except "said recording apparatus further comprises setting means for setting a size of said recording medium; and wherein a notice is made when the width of said recording medium that has been detected by said detection means is different from a width of the size of said recording medium that has been set with said setting means."

21. Elgee teaches "said recording apparatus further comprises setting means for setting a size of said recording medium (38 and 39 of Fig 2; 148 and 150 of Fig 5); and wherein a notice is made when the width of said recording medium that has been detected by said detection means is different from a width of the size of said recording medium that has been set with said setting means (col 10 ln 7-42)." It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to

include setting means and notify the user of a detected width error in the apparatus of Ham, as taught by Elgee, to achieve the predictable results of ensuring that the user properly installed the printing medium so as to prevent potentially printing beyond the width of the medium and damaging the printer, as stated by Elgee.

22. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ham in view of Brookner and Elgee.

23. Regarding claim 33, Ham discloses "carrying means for carrying a recording medium (21 of Fig 2A and 3A); detection means (32 of Fig 3A,B) that can move in a direction that intersects (see Fig 2 and 3 where detection means moves in direction intersecting carrying direction) the carrying direction of said recording medium (vertical direction of Fig 2, right to left of Fig 3) and that is for detecting a width of said recording medium in the direction that intersects the carrying direction of said recording medium (col 4 ln 44-57, col 5 ln 10-26, col 6 ln 31-50); and a recording head for ejecting liquid to record recording information (31 of Fig 2A,B); wherein ON/OFF of an operation through which said detection means detects the width of said recording medium is settable (col 4 ln 40-43, col 6 ln 61 – col 7 ln 3)... wherein the ON/OFF of the operation through which said detection means detects the width of said recording medium is initially set to either one of ON and OFF in accordance with a type of said recording medium (see Figs 4A,B, where different size recording mediums are shown such that the operation described with regards to claim 24 above can occur or not (col 6 ln 61 – col 7 ln 3) based on the type of recording medium)...before said recording head starts the recording of the recording information to the recording medium, said detection means

moves in the direction that intersects the carrying direction of said recording medium and detects the width of said recording medium based on whether or not said recording medium is present (step S14 occurs before S16 of Fig 5); wherein said detection means (32) and said recording head (31) are both provided in/on a moving member (30 of Fig 3A,B) for moving in the direction that intersects (see Fig 2 and 3 where detection means moves in direction intersecting carrying direction) the carrying direction of said recording medium (vertical direction of Fig 2, right to left of Fig 3); and wherein said detection means has a light-emitting member (12b of Fig 2 and 3) for emitting light and a light-receiving member (32 of Fig 2 and 3) for receiving the light that is emitted by said light-emitting member, and detects whether or not said recording medium is present based on an output value of said light-receiving member (col 3 ln 57-60, col 4 ln 51-57)." Thus Ham meets the claimed invention except "a display screen... wherein the ON/OFF of the operation through which said detection means detects the width of said recording medium is initially set to either one of ON and OFF in accordance with a resolution at which the recording information is to be recorded to said recording medium; wherein said recording apparatus further comprises setting means for setting a size of said recording medium; wherein a notice is made when the width of said recording medium that has been detected by said detection means is different from a width of the size of said recording medium that has been set with said setting means."

24. Brookner teaches setting operations "through a display screen (col 4 ln 6-10)." Regarding the resolution limitation, since the limitation set forth in this claim is directed to a method of using the claimed apparatus, the apparatus disclosed by Ham in view of

Brookner and Elgee must only be capable of performing such a method step. Since Brookner teaches a user input display screen, with the combination of Ham in view of Brookner, a user would be capable of setting the operation "in accordance with a resolution at which the recording information is to be recorded to said recording medium." It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to make the operation of Ham settable through a display screen as taught by Brookner to achieve the predictable result of allowing the user to more easily interact with and operate or set the recording apparatus.

25. Elgee teaches "said recording apparatus further comprises setting means for setting a size of said recording medium (38 and 39 of Fig 2; 148 and 150 of Fig 5); and wherein a notice is made when the width of said recording medium that has been detected by said detection means is different from a width of the size of said recording medium that has been set with said setting means (col 10 ln 7-42)." It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include setting means and notify the user of a detected width error in the apparatus of Ham in view of Brookner, as taught by Elgee, to achieve the predictable results of ensuring that the user properly installed the printing medium so as to prevent potentially printing beyond the width of the medium and damaging the printer, as stated by Elgee.

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Walker (US 5940106) discloses a printer controller that operates based on user input through a keypad and a display for providing information to the

user. lida (US 5671163) discloses user can set the apparatus to not measure and compare a measured width to a set width in the case where paper size does not matter for the print job.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Goldberg whose telephone number is (571)272-2728. The examiner can normally be reached on Monday through Friday, 9AM-5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Luu can be reached on 571-272-7663. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LUU MATTHEW/
Supervisory Patent Examiner, Art Unit 2861

/Brian J. Goldberg/
Examiner
Art Unit 2861

